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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/643,194 08/21/00 KLIPPER

R MD-5663/LEA

000157  
BAYER CORPORATION  
PATENT DEPARTMENT  
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IM52/0202

EXAMINER

ZITOMER, F

ART UNIT

PAPER NUMBER

1713

DATE MAILED:

02/02/01

3

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/643,194

Applicant(s)  
Klipper et al.

Examiner  
Fred Zitomer

Group Art Unit  
1713



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-24 is/are pending in the application.

Of the above, claim(s) 16-24 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-15 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-15, drawn to a process of making anion exchangers, classified in class 521, subclass 32.
- II. Claims 16-18 and 22 drawn to anion exchangers, classified in class 521, subclass 25.
- III. Claims 19-21, drawn to a process of treating water, classified in class 210, subclass 688.
- IV. Claim 23, drawn to amidomethylated bead polymers, classified in class 525, subclass 375.
- V. Claim 24, drawn to aminomethylated bead polymers, classified in class 525, subclass 379.

The inventions are distinct, each from the other because:

Inventions of Group I and Groups II, IV and V are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by the materially different process of initiating polymerization with actinic irradiation.

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Inventions of Group II and Group III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in the materially different process of catalysis.

Inventions of Groups (IV or V)/II and Groups IV/V are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate products are deemed to be useful as supports for catalysts and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

During a telephone conversation with Richard E.L.Henderson on January 24, 2001 a provisional election was made with traverse with respect to Groups I and II but without traverse with respect to Groups III to V to prosecute the invention of Group I, claims 1-15. Affirmation of this election must be made by applicant in replying to this Office action. Claims 16-24 stand withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

2.

The abstract of the disclosure is objected to because of the failure to afford a summary of the claimed invention sufficient to enable the reader thereof to ascertain quickly the gist of the invention. Correction is required. See MPEP § 608.01(b).

3.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

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rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meitzner et al., US 4,382,124, and Klipper et al., US 4,952,608, and Corte et al., US 3,006,866, hereinafter Corte '866.

The claimed process is a compilation of generally known steps. Meitzner for example as acknowledged at page 2, lines 27-32 applicant's disclosure teaches instant step (a), viz. the procedure for a monodisperse crosslinked vinylaromatic base polymer. Meitzner also teaches the generally known procedures for alkylating amines when preparing anion exchangers, i.e. the means of alkylation recited in present step (d) [column 11, line 39 - column 13, line 2]. Klipper teaches the amidomethylation and conversion to an aminomethylated bead polymer of instant steps (b) and (c) including the instant embodiments of a phthalimide ether and sulfuric acid catalysis [column 1, lines 27-54; column 3, line 18 - column 4, line 5; claims 3,5,6 and 7]. Corte '866 teaches introducing aminoalkyl groups via chloromethyl phthalimide and subsequent alkylation to form weak or strong anion exchangers, i.e. instant step (d) [paragraph bridging columns 1 and 2; column 3, line 43 - column 4, line 2]. It would have been obvious to prepare anion exchangers according to instant steps (a) to (d) because Meitzner and Klipper and Corte '866 teach each step of the process.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 14: the term "...derivative(s).." as used in the claims is non-limiting. Anything can be a derivative if one is willing to go back far enough. One of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

5.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Corte et al., US 3,994,719 teach separating heavy metals with adsorbents prepared by functionalizing aminomethylated bead polymers with thiourea and derivatives.

6.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred Zitomer whose telephone number is (703) 308-2461. The examiner can normally be reached Monday through Friday from 7:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful David Wu can be reached at (703) 308-2450. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3599.


Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the

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receptionist whose telephone number is (703) 308-2351.

  
FRED ZITOMER, PhD  
PRIMARY EXAMINER  
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Zitomer/fz  
January 28, 2001